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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,966	09/06/2001	Larry Neil Mackey	U 013595-2	6640

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/01/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914966

Applicant(s)

Mackey et al.

Examiner

John Guarise/b

Group Art Unit

1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3-5, 7-13
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

15. Claim 6 contains the trademark/trade name “Caldas 10 resin” and “CoBond 1000 resin”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a resin in a Markush group and, accordingly, the identification/description is indefinite.

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-4,7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites only pseudo thermoplastic starch fibers and the remaining dependent claim recite physical properties (size, dry tensile strength, geometric mean wet tensile strength, basis weight, absorbency, flexibility, and GMDT). Ex Parte Slob, 157 USPQ 172, states the following regarding an article claimed by defining property values:

Claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics;

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thus, the expression “a liquefiable substance having a liquefaction temperature from about 40 degrees Centigrade to about 300 degrees C. And being compatible with the ingredients in the powdered detergent composition” is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; the expression is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Thus, claims 1-4, 7-10 are indefinite for reciting only the desired physical properties of the pseudo thermoplastic starch fibers, rather than setting forth structural and/or chemical characteristics of the absorbent flexible structure comprising pseudo thermoplastic starch fibers.

Specification

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18. The use of the trademarks "Caldas 10 and CoBond 1000", on page 20, lines 17-19, have been noted in this application. It is noted that they are capitalized, however **wherever they appear and they should be accompanied by the generic terminology.** This generic terminology appears to be missing.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Buehler et al 5,516,815.

Buehler describes starch fibers or starch modified fibers (corresponding to the claimed pseudo thermoplastic starch fibers of the claimed invention), (see abstract; column 1, lines 54-55). Buehler describes the starch fibers can be used in absorbent articles, absorbent cotton and wound dressing materials, (which correspond to the claimed absorbent flexible material), (column 2, lines 35-46). Buehler describes the amount of plasticizer, about 50%, in the starch composition which overlaps the claimed invention, (column 6, lines 6-13). It is the Examiner's position that Buehler describes the essential limitation of the claimed invention. Claims lack novelty.

20. Claims 1,5 are rejected under 35 U.S.C. 102(b) as being anticipated by Horsak 2,570,449.

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Horsak describes a pseudo-thermoplastic starch (corresponding to the claimed pseudo-thermoplastic starch) which is made by adding solvents, softeners, glycerine, (which corresponds to the claimed glycerol of the claimed invention) in the amount of 30-50% which overlaps the claimed amount of the claimed invention or fluxes, urea, to produce softening or liquefying properties, (column 1, lines 31-52). Horsak describes the production of this pseudo-thermoplastic starch into fibers and flexible sheets (corresponding to the claimed absorbent flexible article), (column 2, lines 49-55). Horsak describes the making of this pseudo-thermoplastic starch into articles which can be regenerated for other uses and other materials, (column 3, lines 36-69). It is the Examiner's position that Horsak describes the essential components of the claimed invention. Claims lack novelty.

Claim Rejections - 35 USC § 103

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21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1, 2-4, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buehler et al. 5,516,815 in view of Bastioli et al. 5,286,770.

Buehler describes modified starch fibers (which correspond to the claimed pseudo-thermoplastic starch fibers) above in paragraph # 19 above. Buehler differs from the claimed invention because it is silent about the amount of the plasticizer and the amount of the crosslinking agent.

Bastioli describes absorbent articles comprising starch with a synthetic polymer which are an interpenetrated network (corresponding to the claimed pseudo- thermoplastic starch of the claimed invention) with plasticizer in the amount of 2-40 wt. % which overlaps that of the claimed invention, (column 5, lines 1-29). Bastioli describes the amount of the crosslinking agent urea

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which can also be aldehydes, (column 5, lines 1-4, lines 30-31) of about 2-7% which overlaps that of the claimed invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the plasticizer and crosslinking agents of Bastioli in the modified starch fibers of Buehler motivated with the expectation that improved moisture absorption would be evidenced as noted in Buehler, (column 2, lines 32-39). Regarding the properties, since the basic chemistry and structure are exemplified in the references it would be routine in this art to optimize since this only involves routine skill in this art, In re Boesch, 617, F.2d 272, 205 USPQ 215 (CCPA 1980).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

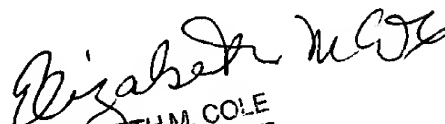
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John J. Guarriello: gj

Patent Examiner

June 27, 2003



ELIZABETH M. COLE
PRIMARY EXAMINER